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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,776	01/23/2002	Yehouda Harpaz		8395

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EXAMINER

RADA, ALEX P

ART UNIT PAPER NUMBER

3714

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,776

Applicant(s)

HARPAZ, YEHOUDA

Examiner

Alex P. Rada

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Appeal Brief

1. In view of the appeal brief filed on May 4, 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Objections

2. Claim 1 is objected to because of the following informalities:

The claims contain italics as well as lack spaces between the references characters and the words that describe them.

The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

The claims also contain capitalized letters throughout. The claims should represent one sentence, starting with a capital letter and ending with a period.

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The claims do not follow the requirements of 37 C.F.R. §1.75 (i) stating that where a claims sets forth a plurality of elements or steps, each element or step of the claims should be separate by a line indentation.

Appropriate correction is required.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,568,683. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4 of the U.S. Patent No. 6,568,683 "anticipate" application serial number 10/031,776 of claim 1. Accordingly, the application of claim 1 are/is not patentably distinct from U.S. Patent No. 6,568,683 of claims 1-4. Here, U.S. Patent No. 6,568,683 of claims 1-4 requires elements a grid of grid points on a flat surface, a character display, a game manager made of a CPU and memory which manages two or more games with a set of basic rules while the application, and the game manager checks for each point the illumination state of the point and of a pattern of

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points around to insure appropriate movement of a player while the application of claim 1 only requires elements a grid of grid points on a flat surface, a display, a game manager made of a CPU and memory which manages one or more games with a set of rules, and the game manager checks to evaluate the legal moves of a player by pre-defined set of imaginary straight lines.

Thus it is apparent that the more specific U.S. Patent No. 6,568,683 of claims 1-4 encompasses the application of claim 1. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

3. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-4 of copending Application No. 10/031890. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 3-4 of the copending Application No. 10/031890 "anticipates" application serial number 10/031,776 of claim 1. Accordingly, the application of claim 1 are/is not patentably distinct from copending Application No. 10/031890 of claims 3-4. Here, copending Application No. 10/031890 of claims 3-4 requires elements a grid of grid points on a flat surface, visible grid points, an illumination source, two colour visible elements, and when a player presses a grid point the board changes the illumination from off\on position to on\off position while the application of claim 1 only requires elements a grid of grid points, illumination of two different colors, and a CPU is notified whenever any of the grid points are pressed and illuminated on a flat surface. Thus it is apparent that the more specific copending Application No. 10/031890 of claims 3-4 encompasses the application of claim 1. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a

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claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claim 1 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of copending Application No. 10/031,942. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 4 of the copending Application No. 10/031,942 "anticipates" application serial number 10/031776 of claim 1. Accordingly, the application of claim 1 are/is not patentably distinct from copending Application No. 10,031,942 of claims 1 and 4. Here, copending Application No. 10,031,942 of claims 1 and 4 requires elements a grid of grid points on a flat surface, visible grid points, an illumination source, two colour visible elements, and when a player presses a grid point the board changes the illumination from off\on position to on\off position while the application of claim 1 only requires elements a grid of grid points, illumination of two different colors, and a CPU is notified whenever any of the grid points are pressed and illuminated on a flat surface. Thus it is apparent that the more specific copending Application No. 10/031,942 of claims 1 and 4 encompasses the application of claim 1. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Golad '441.

7. Golad discloses the following:

An apparatus for a game having a grid of grid points on a flat surface having each grid point being a visible element which is capable of detecting when it is pressed, two different colors allocated to represent players, a CPU, memory, a computer program executed by the CPU, and a game manager evaluating legal moves by each player by checking in turn each of a pre-defined set of imaginary straight lines emanating from the point to evaluate a correct and incorrect move, in which the examiner interprets to be in the computer informing a player on a incorrect move by flashing the correct playing areas on the grid point in straight

lines, which is equivalent to applicant's game manager evaluating legal or illegal moves by a player (column 3, line 54 – column 4, line 9) as recited in claim 1.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg et al. (5,417,425) in view of Othello (Shadows125 Java Applet).

10. Blumberg discloses the following:

A grid of grid points on a flat surface where each grid point is a visible element (Figures 1-4) which is capable of detecting when it is pressed (Column 1, lines 22-30), an illumination source inside and below the surface which is capable of illuminating the visible element (Figures 13-14) by either of two colors (Column 6, lines 37-40), a game manager (Figure 9) connected electronically to the grid points (FIG 9, reference 20) as well as to the illumination source (Figures 9, reference 30), a microcontroller has control over the illumination and coloring of the squares (Column 4, lines 11-14) and also detects when a grid point is pressed (Column 4, lines 11-14), a program and a memory associated with the CPU (Figure 9) and the CPU manages the game and when a player presses a

point, the illuminations of a pattern of points around this point are changed (Abstract).

Blumberg does expressly disclose the following:

When a player touches a point, the games manager checks if it is a legal move, and if it is switches the point to the player's colour to evaluate if a point is a legal move, the games manager checks in turn each of a pre-defined set of imaginary straight lines emanating from the point, assigning a value of 0 to each of these lines that does not pass through an illuminated point, a value of 1 if the closest illuminated point that it passes through is illuminated with the colour of the player, and -1 if it is in the opponent's colour and then compares the sum of the values of all the lines to a fixed number, and if the sum is larger or equal the point is a legal move for the player, the games manager declares as winner the player that has more points of their colour in the end of the game.

Othello teaches the following:

The well-known game of Othello obviates the use of such an electronic game wherein two-colors and an off state are used in the manner disclosed. Othello also offers an electronic version, thus providing a program, wherein there is a grid of grid points on a flat surface wherein each grid points is a visible element which is capable of detecting when it is selected. It offers two colors and a character display. The program has control and is notified when any grid point is selected. When a selection occurs, the program either sets an off state to a player's color or changes opponent's colors if they are around the point. When all

the points on the board are used, the program using the character display, declares, as the winner, the player with the majority of the points.

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate the program disclosed by Othello into a structure such as the one disclosed by Blumberg. As Othello merely represents a program, it could easily be adapted or used by a skilled artisan to work in the structure of Blumberg et al. wherein its addition would add lasting enjoyment to the device. As Blumberg already supports multiple color lights as well as an off state, one would be motivated to do this, as discussed above, to provide a more challenging and amusing device, which would continue amuse experienced players.

Blumberg also does not expressly disclose a character display. However, Bloomberg does disclose an audio device, which is used to provide feedback information (Column 4, lines, 15-17). It would be obvious to a skilled artisan that in providing feedback, the device would indicate a win, as is known in the art, in order to stimulate the player and provide encouragement and recognition. Further, it would have been an obvious design choice to employ a display as opposed to an audio device as both satisfy the requirement of providing feedback to the player. One motivation for using a character display would be that the player could play the game without disturbing others (i.e. in cars, planes, or trains), yet still receive feedback. This device would be used in the Blumberg et al. system to indicate to the player they are the winner as all the points are switched on and therefore have the majority.

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Conclusion

II. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Orak 5,743,796 and Olti 5,603,500 disclose a game having a plurality of spaces with indicators and a game which uses lights to control states.

British Othello Federation, Rules of Othello, circa 1998 <http://w3.britishothello.org/>

OS2World, Lites Out!, Jan. 1997, taken from Internet, <http://w3.os2world.com/games>

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Jessica Harrison can be reached on 703-308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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[Signature]
JOHN M. HOTALING, II
PRIMARY EXAMINER